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January 4, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: **Appeal No.: 2005-2622**
Serial No.: 09/923,089
Applicant: Harold V. Putman, et al.
Filed: August 6, 2001
Conf. No.: 9431
Docket No.: D-1144

Sir:

Please find enclosed Appellants' Request for Rehearing pursuant to 37 C.F.R. § 41.52 for filing in the above-referenced case.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	**Harold V. Putman, et al.**	
Appeal No.:	**2005-2622**	Art Unit **2876**
Serial No.:	**09/923,089**	
Confirm. No.:	**9431**	
Filed:	**August 6, 2001**	Patent Examiner **Seung H. Lee**
For:	**Automated Banking Machine System And Method**	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 41.52

Sir:

Appellants hereby submit a Request for Rehearing pursuant to 37 C.F.R. § 41.52 concerning the above-referenced Application. The Request for Rehearing seeks further review of the Decision of the Board of Patent Appeals and Interferences in Appeal No. 2005-2622 dated November 16, 2005 ("**Decision**").

Statement of Points Believed to Have Been Misapprehended or Overlooked by the Board

The claim interpretations and findings in the Decision are not supported by the evidence of record with respect to claims 1, 8, 9, 18, 19, 26 and 27

The Decision affirmed the rejections of claims 1, 8, 9, 18, 19, 26 and 27 by holding that "Clark determines whether the input signals are from a **user-type** of input devices, which has **user capabilities**, or from an **operator-type** of input device, which has **operator capabilities**, and then responsively display a corresponding user interface." (emphasis added). Appellants respectfully submit that this finding has no support in Clark or in any other prior art of record.

The Decision has improperly construed the claim elements, which in each of these claims recites an automated banking machine which includes a computer that operates to determine (and the method claims recite the method step of determining) the type of input device that is associated with a display device on the automated banking machine. (see Appendix attached) The Board construed these claim elements as not determining whether the type of input device is of one structural type or another (e.g., a mouse, a keypad, or a function key), but rather as determining whether an input device is being used by an operator or a user. There is no support for such an interpretation in the Specification, nor would a person having skill in the art interpret the claims as was done in the Decision.

Terms that are included in patent claims are interpreted in the context of the specification which describes the invention. *Phillips v. AWH Corp. et al.*, Nos. 03-1269, 03-1286 (Fed. Cir. July 12, 2005). It is plainly improper for the Decision to interpret Appellants' claim terms in a manner which has no support in the Specification. It is further improper for the Decision to

adopt claim interpretations which are contrary to Applicant's teachings about the invention, and which (as later discussed in detail) are inconsistent with the recitation in the claims of the features and relationships which define the claimed invention. Claims 1, 8, 9, 18, 19, 26 and 27, when properly construed in view of Appellants' Specification do not support the Board's conclusion that the term "type" corresponds to "user-type" or "operator-type". Nor is there any support for the Board's conclusion that the recited claim term "capabilities" corresponds to "user capabilities" or "operator capabilities". No person having skill in the pertinent art, properly interpreting the claims in view of the Specification as required by the Court of Appeals for the Federal Circuit, would interpret these claims as was done in the Decision.

However, even if there was some evidence or support (which there is not) for the conclusion that "type" and "capabilities" could be construed as stated in the Decision, there would still be no evidence or support for the conclusion that Clark or any other applied art, discloses or suggests determining the type or capabilities of an input device, and then outputting user interfaces from an automated banking machine display responsive to the determined type or capabilities of the input device.

For example, the Decision (e.g., page 10, line 9 to page 11, line 10) holds that Clark has the ability to perform different functions responsive to inputs from different sources (e.g., user panel keypad 16 or operator panel keypad 27). Such ability does not require (nor teach or suggest) Applicants' recited features which include outputting different user interfaces through different display devices on the banking machine, responsive to separate determinations made by a processor in the machine as to the type or capabilities of the particular input device associated with the corresponding display device. Nor would the recited features be inherent in Clark.

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that a missing element not explicitly taught is nonetheless necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

The processor in Clark does not necessarily determine anything about the type or capability of an input device. For example, the processor in Clark could have a hard coded read-only memory that responds to the different inputs from a fixed set of connected input devices. In such a system there would never be any need for Clark's processor to make a determination as to what type or capabilities are associated with the input device of Clark's user panel, or what type or capabilities are associated with the input device of Clark's operator panel. Likewise there would never be any need for Clark's processor to determine whether the device is for use by a user or operator. Appellants' recited features are not "necessarily present" in Clark, and therefore not inherent.

Nowhere does Clark teach or suggest that the user or operator keypads on the Clark ATM would ever be replaced with different types of input devices with different capabilities. Thus there is no need, teaching, suggestion, or motivation in Clark for the Clark ATM to determine the types or capabilities of input devices associated with different display devices, because the input devices are never changed to different types with different capabilities. Even if it were physically

possible to replace the input devices of Clark with different types of input devices (which it is not), nowhere does Clark disclose or suggest that its processing unit is capable of operating the ATM properly after the installation of new input devices that are of a different type and/or that have different capabilities from those devices described in Clark. Clark lacks any capability to determine the nature of new input devices and their types or capabilities, as expressly recited in Applicants' claims.

There is no need or capability in Clark to determine the type or capabilities of existing or new input devices associated with display devices. Appellants' recited claim features that determine the type or capabilities of input devices of an automated banking machine, and provide screen outputs in user interfaces in response to such determinations, are neither disclosed, suggested nor inherent in Clark. As a result, there is no support for the Board's holdings which underlie the rejections of claims 1,8, 9, 18, 19, 26 and 27.

The Decision has not explained what are "user capabilities" or "operator capabilities". Such terms are not used in the prior art or Appellants' Specification. There is no evidence of record that these terms would have any particular meaning to one having ordinary skill in the art to which the invention pertains. It is submitted that the holding in the Decision is improper because it is without any evidentiary support in this regard. Further, the Decision has not explained how such user or operator capabilities are determined. For example, Clark teaches that the same structural type of device, namely a keypad, is used on both Clark's user and operator panels. Clark does not teach any structural differences between these keypads and it appears that each of the keypads has the same capabilities of providing inputs representative of key presses.

Clark does not teach that one of the keypads has any particular user capabilities, while the other keypad has any particular operator capabilities. The Decision has not addressed, let alone provided any prior art support, for the position that it is even possible to distinguish which input devices have "user capabilities" and which input devices have "operator capabilities". Appellants respectfully submit that the prior art of record does not disclose or suggest, apparatus or methods including the ability to determine user type capabilities and operator type capabilities of input devices.

Nowhere does Clark, or any other cited art, teach or suggest determining "user-type", "operator type", "user capabilities", or "operator capabilities" of input devices associated with display devices. Nowhere does Clark, or any other evidence of record, teach or suggest outputting user interfaces through a display responsive to such determinations. Thus, even if the Decision's claim construction determination is correct and (Appellants submit that it is not), the prior art evidence of record still does not provide any support for the rejections of claims 1, 8, 9, 18, 19, 26 and 27.

Appellants also respectfully assert that the claim construction used in the Decision is not consistent with or supported by the use of the claim terminology in the Specification. For example, claim 1 specifically recites "a first input device of a first type" and "a second input device of a second type and different from the first type". As used in the Specification, the recited term "type" corresponds to the physical features and/or capabilities of the input device, and not any form of user or operator designations associated with the persons using the input devices. For example, on page 8, lines 14-22; Page 12, line 12, to Page 13, line 12, the Specification discusses a mouse type input device and a function key type input device as

different types of input devices. Nowhere does the Specification or any cited art provide any basis for a claim interpretation for the recited element of a software application that determines types of input devices associated with respective display devices, other than something that distinguishes between different physical forms of such input devices.

The claim interpretation in the Decision is totally contrary to the use of the terminology within the Specification or any cited art. It is contrary to the rules for claim interpretation the Federal Circuit has mandated in *Phillips v. AWH, supra.* As such, Appellants submit that the claim construction adopted in the Decision is without support, arbitrary, capricious and improper.

Further, establishing the impropriety of the Decision is that the Decision's claim interpretation is not consistent with the express recitations included within the claims, as the Decision's interpretation would make a number of Applicants' dependent claims (e.g., claims 7, 14 20-23, 30-36 and 39) impossible to carry out. For example, claims 6 and 7 which depend from claim 1 recite "wherein the at least one computer is operative to invoke an event processor . . . responsive to an input from **either the at least one first input device or the at least one second input device**" and "wherein the at least one computer is operative responsive to the event processor to cause the machine to perform at least one **maintenance related function**". Claim 7 recites that "the maintenance related function" can be performed responsive to an input from either the first input device (e.g., a function key) or the second input device (e.g., a mouse button).

Using the Decision's claim construction, the key pad (16) of the user panel in Clark would be fixed as a "user-type" input device. This results because Clark does not disclose or suggest how key pad (16) could ever be interpreted to be an "operator-type" input device. As the

key pad (16) of the user panel in Clark would always be a "user-type" input device, this would always prevent the processing unit of Clark from ever outputting on a display associated with this particular input device, a user interface capable of performing the recited at least one "maintenance related function". Therefore claim 7 could never be carried out.

The claim interpretation adopted in the Decision is not only contrary to the use of claim terms in the Specification, it is also is incompatible with the features of the invention as recited in the claims. This interpretation also has no support in any cited art. As such, it is respectfully submitted to be improper.

Appellants further submit that even if the incorrect interpretation adapted in the Decision is used, the Decision is still incorrect because nothing in the cited art discloses or suggests an automated banking machine that determines anything about the type or capabilities of an input device associated with a display, and then provides a particular user interface in response to the determination regarding such type or capabilities.

It is requested that the rejections of claims 1, 8, 9, 18, 19, 26 and 27, as well the claims that depend therefrom, be withdrawn.

The Decision has failed to address, let alone establish, that all of the features recited in claims 18 and 26 are disclosed or suggested in the prior art.

On page 9, lines 1-4, the Decision states that giving claims 1, 8, 18 and 26 their broadest reasonable construction, the limitations require determining either whether an input device is of a first or second type, or else determining a capability of the input device, and then responsively

displaying a corresponding user interface. However, this characterization of overlooks other features specifically recited in the claims.

Both claims 18 and 26 recite as step (c) "presenting at least one first user interface through a first display device responsive to the determined at least one first type [of a first input device] and the at least one first document". Nowhere has the Decision addressed, let alone established, where the applied art discloses or suggests presenting a first user interface through a first display device responsive to **both** a **determined first type** of a first input device and **at least one first document** provided to / received by a computer of the machine.

The Decision on page 20, with respect to claims 4 and 10, states that Coutts shows software of which a part corresponds to the claimed "first document". This is not correct. Coutts does not disclose or suggest Appellants' two separately recited elements of "a software application" and "a first document." Rather, Coutts discusses using Java software which is in the form of byte code or applets (Column 3, lines 24-25). Coutts does not disclose or suggest that its Java software comprises documents which are provided to or received by an automated banking machine.

The holding in the Decision that Coutts discloses a "document" as recited in Appellants' claims 18 and 26 is not supported by the Specification or the use of the claim term "document" therein. For example, the Specification states that in the exemplary embodiment the user interface "documents" include XML formatted command instructions which define features of the user interface. Nowhere does Coutts disclose or suggest that its Java software comprises XML documents or anything structurally or functionally equivalent. Further, nowhere does the

Specification support the holding in the Decision that Appellants' recited "documents" are the same as or in any way correspond to Coutts' Java code.

Both Appellants' Appeal Brief and Reply Brief argued in detail that the features and relationships recited in step (c) of both claims 18 and 26 are not disclosed or suggested in the applied art. The Decision with respect to claims 18 and 26 has no support for the holding that these features are found, disclosed or suggested in the applied art. The Decision has not provided *prima facie* conclusion of obviousness. It is submitted the rejections of claims 18 and 26 in the Decision is improper and should be withdrawn.

The claim construction and findings in the Decision with respect to claim 29 are not supported by the evidence of record

The Decision asserts at page 13, line 14, that withdrawing cash is a banking service as is depositing money. However, claim 29 does not recite "banking service". Rather, claim 29 specifically recites "wherein both the first user interface and the second user interface are adapted to enable an authorized user to perform servicing operations with the machine". Appellants respectfully submit that neither the use of the claim terminology in the Specification, nor any cited art nor reasonable interpretation of the claim language by one having skill in the relevant art, support the Decision's claim that the recited "servicing operation" corresponds to a banking service such as withdrawing cash using the machine. Rather, as disclosed in the Specification, the term "servicing" corresponds to maintenance and configuration related functions performed on the ATM by an authorized operator who performs such service functions. For example, the Specification states at page 21, lines 9-12, that:

> Because the complexity of the input requirements for servicing and configuring the machine are generally higher than for conducting consumer transactions, the rear user station 14 may include different and/or relatively more flexible input devices than the front user station such as a full keyboard 26 and a pointing device 24.

It is clear from this statement that the Specification distinguishes operations corresponding to servicing and configuration of the machine, from operations for conducting consumer transactions (e.g., withdrawing or depositing cash).

In addition, the Specification states at page 35, lines 1-7, that:

> In the exemplary embodiment when the automated banking machine is manually taken down for servicing, the maintenance interface application 188 is operative to send the screen output application 180 a message, which prompts the screen output application to display the out-of-service screen 190. When the servicer has completed servicing the machine, the maintenance interface application is operative to send the screen output software a further message, which instructs the screen output application to redisplay screens for the consumer interface software application 186.

It is clear from these statements in the Specification, the word "servicing" corresponds to maintenance related functions which require the machine to be placed in a mode which does not

allow consumer transactions for users (such as withdrawing cash from an account of the user), to be performed.

The Decision has not provided any evidence to support its claim interpretation that the recited term "servicing" corresponds to performing consumer transaction services such as withdrawing cash from an account. Indeed not only is this finding not supported, it is directly at odds with the normal meaning of the recited term, and the manner in which the term is used in the Specification. It follows that the Decision has no support for the position that the prior art of record discloses or suggests the recited feature, that both the first user interface and the second user interface are adapted to enable an authorized user to **perform servicing operations** with the machine while positioned **adjacent either the first user station or the second user station of the machine**. Therefore, it is submitted that the rejection of claim 29 is improper and should be withdrawn.

The Decision has failed to consider Appellants' arguments presented in the Appeal Brief and Reply Brief with respect to claims 3, 5-7, 9, 11, 19 and 27

The Decision states that Appellants' arguments with respect to claims 3, 5-7, 9, 11, 19 and 27, do not constitute arguments that the claims are separately patentable, and do not challenge the rejection of the individual claims with any reasonable specificity. Appellants respectfully submit that these findings are contrary to the record, and have no factual or legal support.

With respect to claim 5, for example, Appellants' arguments (the entire page 17 in the Appeal Brief) included a detailed discussion refuting the assertions made in the Action regarding

the teachings of Coutts and Clark. How can the Decision credibly hold that Appellants failed to present arguments with regard to this claim?

The Decision's characterization of the arguments presented with respect to claims 3, 5-7, 9, 11, 19 and 27 in the Appeal Brief is not accurate. The record provides no support for the holding that the rejections of these claims was not challenged by Appellants with reasonable specificity.

It was specifically pointed out and argued in the "Applicable Legal Standards" section of Appellants' Appeal Brief (Pages 5-7), that to establish *prima facie* obviousness, the Patent Office must show that all the elements and relationships recited in the claim are known in the cited art. If the Office does not produce a *prima facie* case, then Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Appellants' arguments with respect to claims 3, 5-7, 9, 11, 19 and 27 in the Appeal Brief, separately and specifically point out for each claim, that there are specifically recited features and relationships which are not disclosed or suggested by the applied references. Further, Appellants' arguments with respect to claims 3, 5-7, 11, 19 and 27 in the Appeal Brief pointed out that the rejections in the Action, do not factually support any *prima facie* conclusion of obviousness. No additional arguments or points are required to have been asserted by Appellants to legally establish that the rejections in the Action were not proper. Thus with respect to the Action, the Office had failed to establish any *prima facie* showing of obviousness for claims 3, 5-7, 11, 19 and 27, and had further failed to show that claim 9 was anticipated by the prior art.

In Response to Appellants' showing that the Office failed to establish *prima facie* obviousness or anticipation, the Examiner in his Answer attempted to point out where some of

the recited features in claims 3, 5-7, 9, 11, 19 and 27 were found in the applied art. These new assertions, arguments, and/or grounds of rejection, were never presented previously by the Office. In response to these new assertions, arguments, and/or grounds of rejection, Appellants' Reply Brief pointed out in detail where the Examiner's Answer was legally deficient in showing that the applied art discloses or suggests all of the features and relationships recited in claims 3, 5-7, 9, 11, 19 and 27. Appellants' Reply Brief established that the Examiner's Answer had again failed to establish *prima facie* obviousness and anticipation with respect to these claims.

The following chart shows where in their Reply Brief Appellants specifically refuted the contentions made in the Examiner's Answer with regard to any prior art showing of features recited in these claims.

CLAIM	ARGUMENT
Claim 3	Page 9, lines 4-18
Claim 5	Page 10, lines 9-17
Claims 6-7	Page 10, line 18 - page 11 line 16
Claim 9	Page 5, line 14 - page 6, line 18 (claim 9 being specifically addressed on page 6, lines 10-18)
Claim 11	Page 12, lines 6-17
Claims 19-20	Page 16, line 18 - page 17, (claim 19 being specifically addressed on page 16, line 18 - page 17, line 10)
Claim 27	Page 21, lines 1-13

The Decision has failed to consider Appellants' arguments presented in the Reply Brief with respect to claims 3, 5-7, 9, 11, 19 and 27. These arguments challenge and refute in detail, on an element by element basis, that in the applied references relied on in the Examiner's Answer teach or suggest all of the elements and relationships recited in each respective claim. Appellants' detailed and specific arguments in the Appeal Brief and Reply Brief with respect to each of claims 3, 5-7, 9, 11, 19 and 27 cannot be accurately characterized as not challenging the rejections with any reasonable specificity.

The Board has no legal or factual support for its position ignoring Appellants' detailed arguments in the Reply Brief or the Appeal Brief. The Board is required to consider the arguments in the Appeal Brief as well as in the Reply Brief. The Decision is not supported by any evidence that contradicts Appellants' clear and detailed showing in both the Appeal Brief and Reply Brief, that Clark, and/or Coutts do not disclose or suggest the features and relationships recited in claims 3, 5-7, 9, 11, 19 and 27. Thus the rejections of claims 3, 5-7, 9, 11, 19 and 27 based on Appellants' alleged failure to argue the patentability of each claim is without support, and should be withdrawn.

The Decision has made findings with respect to claim 2 which have no support in the evidence of record and which do not support the rejection of the claim

The Decision at page 17 speculates that a message on a user's display 20 in Clark could be prompted by entry into the Supervisor Mode of an operator's panel (26). No such message is taught or suggested in Clark, but rather is conjured up through speculation by the Board based on the alleged desirability of such a message. However, the alleged desirability of such a message is

not taught or suggested in Clark or in any other prior art of record. The Decision has no support by way of any prior art teaching, suggestion, or motivation, to modify Clark to include such a proposed message. Thus the basis on which claim 2 is rejected is mere speculation that is not supported by any evidence of record.

The Decision also compounds the error associated with this unsupported speculation by affirming the obviousness of claim 2 (as well as claim 3) based on a finding that this conjured up message on the user's display, would have been related to the Supervisor Mode menu on the operator's display (28). Appellants respectfully submit that even if such a message could be regarded as related to the Supervisor Mode (even though the prior art evidence of record does not disclose or suggest such a message), this finding still would not support the Decision's holding that each of the features and relationships recited in claim 2 are found in the applied art.

For example, claim 2 recites that the computer of the claimed automated banking machine is operative to cause a desktop environment to be generated which spans both first and second display devices on the machine. The Decision's alleged relationship between the purported message on a user display and activity associated with an operator display, still would not disclose or suggest a desktop environment which spans both first and second display devices, as specifically recited. Further, there is no evidence that the recited desktop environment spanning feature would be inherent in Clark.

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based

on probabilities or possibilities. It is plainly improper to reject a claim based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

For example, it is possible that Clark could produce a first desktop on the user display of the automated banking machine, and a totally separate desktop on the operator display, and still display the (totally unsupported) message as asserted in the Decision. The Decision has not shown by citation to any evidence of record that it is necessary for a single desktop environment to span both the user and operator displays in Clark to enable the purported conjured up message to be displayed on the user display responsive to activity on an operator display. Thus the features recited in claim 2 are not necessary present in Clark.

The Decision fails to show where the applied references disclose or suggest each of the features and relationships recited in claim 2. It follows that the rejection of claim 2 as well as claim 3 are without legal support should be withdrawn.

The Decision includes findings with respect to claims 4 and 10 which have no support in the evidence of record and which do not support the rejections of the claims

At page 20, the Decision asserts that Coutts evidences that various software, which comprises computer instructions, is used to operate an automated banking machine. The Decision further states in its findings, that part of the Coutts software corresponds to the claimed "software application," while another part corresponds to the claimed "first document". The Decision then affirmed the rejections of claims 4 and 10 based on the finding that the ATM

displays a user interface responsive to both parts. Appellants respectfully submit that these findings have no support in the evidence of record.

The Decision has arbitrarily split the software shown in Coutts into the alleged "part" or "another part," and has then held without any basis or support in the cited art, that these alleged parts correspond to two separate elements recited in the claims, namely a "document" and a "software application". Nowhere does the applied art disclose or suggest that the software of Coutts may be split into two parts, let alone parts corresponding to a "document" and a "software application". Further, the Decision fails to point to any evidence of record supporting its holding that the Coutts ATM displays a user interface responsive to both of these parts.

Coutts discusses using Java software which is in the form of byte code or applets (Column 3, lines 24-25). Coutts does not disclose or suggest that the its Java software comprises any form of documents which are provided to or received by an automated banking machine. The Decision's holding that Coutts' software includes a form of "documents" is not supported by the explanation of what comprises a document used in the description of Appellants' invention as set form in the Specification. The Specification states that in the exemplary embodiment, the user interface documents include XML formatted command instructions which define features of the user interface. Nowhere does Coutts disclose or suggest that its Java software comprises XML documents or anything structurally or functionally equivalent. Further, nowhere does the Appellants' Specification or any cited art, support a finding that the recited "documents" in the claims correspond to Coutts' Java code.

Even if such assertions in the Decision regarding splitting Coutts' software into parts which include a first document were supported by the evidence of record (which they are not),

these assertions do not establish that the specific features and relationships specifically recited in the claims, are disclosed or suggested in any cited art.

Claim 4 recites that "the at least one computer is operative to cause output of the first and second user interfaces responsive to the at least one first document." However, nowhere does the Decision show where the applied art discloses or suggests these features. For example, even if the prior art did show that an automated banking machine displays a user interface responsive to the alleged "part" and "another part", such a finding says nothing about where the prior art shows the output of **both a first and a second user interface** on first and second display devices of an automated banking machine responsive to the at least one first document. Nowhere does Clark or Coutts alone or in combination teach or suggest these features. The Decision has shown nothing to support this rejection of claim 4.

With respect to claim 10, the claim recites that "the at least one software application is operative to output the user interface for each user station, responsive to the command instructions" in the document. However, the Decision not shown that any applied art discloses or suggests these features. For example, even if the prior art did show that an automated banking machine displays a user interface responsive to the alleged "software part" and "another part" (which it does not), such a finding says nothing about where the prior art shows software that outputs the user interface for **each user station** (at least two user stations), responsive to the command instructions in the document. Nowhere does Clark or Coutts alone or in combination teach or suggest that the user interfaces for each of the at least two user stations of the automated banking machine are output by software responsive to command instructions in a (single) document. The Decision has no support for the rejection of claim 10.

The Decision has improperly grouped claims 12 and 13 and failed to consider the separate arguments presented with respect to claim 13 in the Appeal Brief

Claims 12 and 13 were separately argued in the Appeal Brief under separate headings. (see pages 19 and 20) Further, the Appeal Brief specifically stated that no groups of claims stand or fall together. Appellants' arguments with respect to claims 12 and 13 under a single heading in the Reply Brief was in response to the arguments in the Examiner's Answer which were directed to both claims 12 and 13 under a single heading.

Nowhere in the Rules or under 37 C.F.R. § 41.41 with respect to Reply Briefs, is there a requirement that each claim must be argued individually and under a separate heading in order to have the Board consider the patentability of the claims separately. Such a requirement is only found with respect to Appeal Briefs under 37 C.F.R. § 41.37.

Further, nowhere does the Rule, or the PTO's pertinent Answers to Comments concerning the proposed rule, (e.g., Comment 72, Fed. Reg. Vol. 69, No. 155, page 49980) with respect to 37 C.F.R. § 41.41 require that the Arguments section of a Reply Brief argue each claim individually under a separate heading in order to have the Board consider the patentability of the claims separately.

Appellants have properly argued each of claims 12 and 13 individually under separate headings in the Appeal Brief as required, and therefore did not waive the requirement that the Board consider the patentability of claims 12 and 13 separately.

The Decision has no support, nor is there any evidence that refutes Appellants' arguments and detailed showings, in both the Appeal Brief and Reply Brief, that Clark and Coutts do not

disclose or suggest all the features and relationships recited in claim 13. The rejection of claim 13 is improper and should be withdrawn.

The Decision has failed to address let alone establish that all of the features recited in claim 12 are disclosed or suggested in the prior art.

The claim interpretation related to claim 12 in the Decision (at page 21) only listed "at least one event processor software component in operative connection with the computer" as being a pertinent feature. Appellants disagree that the prior art discloses or suggests this alleged feature. However, claim 12 also specifically recites additional features that are not disclosed or suggested in the prior art, that have not been considered by the Decision.

For example, nowhere has the Decision shown where any prior art discloses or suggests that "the at least one software application is operatively responsive to . . . either a selection . . . from the pointing device or selection . . . from the at least one key, to invoke a common function of the event processor". Also, the Decision's basis for reversing the rejections of claims 14, 20-23, 30-36 and 39 (at pages 14-15) suggests the Board acknowledged that this recited feature of invoking a common function from different user interfaces as recited in claim 12, is neither found nor suggested in the applied art.

The Decision is supported by no evidence that shows that this recited feature is disclosed or suggested in the prior art, and the rejection of claim 12, as well as claim 13, should be withdrawn.

The Decision failed to consider Appellants' arguments with respect to claim 37

The Decision's statement in upholding the Examiner's rejection of claim 37 that ". . . appellants have not addressed, let alone shown error in his specific findings," has no factual or legal support.

With respect to claim 37, the Examiner's Answer discussed combining the dual interface ATM machine of Clark with the Java program of Coutts to meet the claimed limitations. In response, Appellants specifically stated in their Reply Brief that they did not agree that the asserted combination includes each of the features and relationships recited in claim 37. The Reply Brief then went on to point out in detail each specific feature and relationship recited in claim 37 which is not found in the applied references of Clark and Coutts. (see page 25, line 18 - page 26, line 15) Further, the arguments in the Reply Brief with respect to claim 37 concluded with the legal basis showing the rejection is improper, namely that the Answer did not factually support any *prima facie* conclusion of obviousness.

Appellants therefore properly made a detailed showing that the Examiner's Answer did not factually support a *prima facie* conclusion of obviousness. Because the Decision is supported by no evidence that Clark and Coutts disclose or suggest the features and relationships recited in claim 37, the rejection of claim 37 should be withdrawn.

To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142. With respect to claim 37, the Decision has failed to address, let alone point to any evidence of record that establishes that Clark or Coutts disclose or suggest a software application that is operative to

include in a first user interface, responsive to at least one command instruction in a document and the first input device type, at least one first user interface element that is adapted to be selected through the at least one first input device. Further, the Decision has failed to address, let alone show, that Clark or Coutts disclose or suggest that the software application operates to include in a second user interface responsive to the at least one command instruction and the second input device type, at least one second user interface element adapted to be selected through the at least one second input device. Appellants respectfully submit that the applied references do not disclose or suggest these features.

Also, claim 37 specifically recites that the at least one document includes the "at least one command instruction". Thus the recited software application is operative to cause both the first user interface element and the second user interface element to be included in the respective first and second user interfaces on a single automated banking machine responsive to the same "at least one command instruction". Nowhere does the Decision address, let alone provide any evidence to support, that Clark or Coutts disclose this recited feature.

As discussed previously, Clark and Coutts do not disclose or suggest the recited "at least one document". Coutts discusses using Java software which is in the form of byte code or applets (Column 3, lines 24-25). Coutts does not disclose or suggest that its Java software comprises recited documents, which documents are provided to or received by an automated banking machine. Also, the Decision is not supported by the description of the claim term "document" in the Specification or any other evidence. For example, the Specification states that in the exemplary embodiment the user interface documents include XML formatted command instructions which define features of the user interface. Nowhere does Coutts disclose or suggest

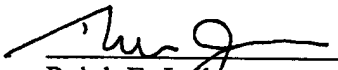
that its Java software comprises XML documents or anything structurally equivalent. Further, nowhere does the Specification or any other cited art support a finding that the recited documents correspond to Java.

As the Decision has no evidence to support that the applied art discloses or suggests the features recited in claim 37, withdrawal of the rejection of claim 37 as well as claim 38, is respectfully requested.

CONCLUSION

Appellants have shown herein that there are several points that have been misapprehended or overlooked by the Board in its Decision. Reconsideration of the Decision and withdrawal of the remaining rejections of the pending claims is respectfully requested.

Respectfully submitted,



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APPENDIX OF CLAIMS

Pending Claims in Application Serial No. 09/923,089
(Italics included to highlight elements discussed in Request for Rehearing)

1. An automated banking machine apparatus comprising:

at least one computer;

a plurality of transaction function devices in operative connection with the at least one computer;

a first display device and a second display device in operative connection with the at least one computer;

a first input device of a first type associated with the first display device and a second input device of a second type and different from the first type associated with the second display device, each of the first and second input devices in operative connection with the at least one computer; and

at least one software application operative in the at least one computer, wherein *the at least one software application is operative to determine the first and the second types of the first and the second input devices,* wherein the at least one software application is operative to *cause a first user interface to be output through the first display device*

responsive to the determined first type of the first input device, and wherein the at least one software application is operative to *cause a second user interface different from the first user interface to be output through the second display device responsive to the determined second type of the second input device.*

2. The apparatus according to claim 1, wherein the at least one computer is operative to cause a desktop environment to be generated, wherein the desktop environment spans the first and second display devices.

3. The apparatus according to claim 2, wherein the at least one computer is operative responsive to the at least one software application to cause the first user interface to be produced in a first portion of the desktop environment that is being output through the first display device, and to cause the second user interface to be produced in a second portion of the desktop environment that is being output through the second display device.

4. The apparatus according to claim 1, further comprising at least one first document in operative connection with the at least one computer, wherein *the at least one computer is operative to cause output of the first and second user interfaces responsive to the at least one first document.*

5. The apparatus according to claim 4, wherein the at least one first document includes a plurality of command instructions that correspond to hardware independent user interface elements.

6. The apparatus according to claim 5 wherein the at least one software application includes at least one event processor, wherein the command instructions are operative to specify an event processor, wherein the at least one computer is operative to invoke an event processor responsive to at least one of the command instructions and responsive to an input from either the at least one first input device or the at least one second input device.

7. The apparatus according to claim 6, wherein the at least one computer is operative responsive to the event processor to cause the machine to perform at least one maintenance related function.

8. An automated banking machine apparatus comprising:

a computer;

at least two user stations in operative connection with the computer, wherein each user station includes at least one display device and at least one input device; and

at least one software application operative in the computer, wherein *the software application is operative to determine at least one capability of at least one input device included in each user station,* and wherein the at least one software application is operative to *cause a user interface to be output through the display device included in each user station, wherein the user interface for a user station is output responsive to the at least one capability associated with the at least one input device included in the user station.*

9. The apparatus according to claim 8, wherein for each user station, the corresponding *user interface includes at least one user interface element that is adapted, responsive to the determined at least one capability, for user interaction through the at least one input device included in the user station.*

10. The apparatus according to claim 8, further comprising a document in operative connection with the computer, wherein the document includes a plurality of command instructions, wherein *the at least one software application is operative to output the user interface for each user station, responsive to the command instructions.*

11. The apparatus according to claim 10, wherein an input device included in a first of the user stations includes a pointing device, and wherein an input device included in a second of the user stations includes at least one key, wherein the at least one software application, responsive to a first command instruction in the document and a determined capability of the pointing

device, is operative to generate a first user interface element in the first user interface that is adapted for selection with the pointing device, and wherein the at least one software application, responsive to the first command instruction and a determined capability of the at least one key, is operative to generate a second user interface element in the second user interface that is adapted for selection with the at least one key.

12. The apparatus according to claim 11, further comprising at least one event processor software component in operative connection with the computer, wherein the at least one software application is operatively responsive to the first command instruction and either a selection of the first user interface element with at least one first input from the pointing device or a selection of the second user interface element with at least one second input from the at least one key, to invoke a common function of the event processor component.

13. The apparatus according to claim 12, further comprising at least one transaction function device in operative connection with the computer, wherein the event processor component is operative to cause the at least one transaction function device to perform an operation responsive to either the first input or the second input.

14. The apparatus according to claim 11, wherein the computer is operative responsive to the first command instruction and either a selection of the first user interface element with at least one first input from the pointing device or a selection of the second user interface element with at

least one second input from the at least one key, to have the machine perform a common maintenance operation.

15. The apparatus according to claim 10, further comprising at least one second document that is associated with the first document, wherein the first document includes a first command instruction and a second command instruction; wherein the second document includes a third command instruction that corresponds to the first command instruction; wherein the first command instruction includes a first label in a first human language; wherein the third command instruction includes a second label in a second human language that has a meaning corresponding to the first label; and wherein the at least one software application is operative to output each user interface with indicia in the second human language responsive to both the first and second documents.

16. The apparatus according to claim 15, wherein the at least one software application is operative to generate each user interface with user interface elements that correspond to the second and third command instructions.

17. The apparatus according to claim 16, wherein the at least one software application is operative to generate each user interface responsive to the second label being substituted for the first label.

18. A method comprising:

a) providing at least one first document to an automated banking machine;

b) *determining at least one first type associated with a first input device on the machine,* wherein the first input device is associated with at least one first display device on the machine;

c) *presenting at least one first user interface through the first display device, responsive to the determined at least one first type and the at least one first document.*

19. The method according to claim 18, further comprising:

d) *determining at least one second type associated with a second input device on the machine,* wherein the second input device is associated with a second display device on the machine;

e) *presenting at least one second user interface through the second display device, responsive to the determined at least one second type* and the at least one first document.

20. The method according to claim 19, further comprising:

f) performing a first function responsive to the at least one first document and a first input through the first input device; and

g) performing the first function responsive to the at least one first document and a second input through the second input device.

21. The method according to claim 20, wherein in each of steps (f) and (g), performing the first function includes dispensing cash from the machine.

22. The method according to claim 20, wherein in each of steps (f) and (g), performing the first function includes performing a maintenance related operation with the machine.

23. The method according to claim 20, wherein in each of steps (f) and (g), performing the first function includes invoking at least one event processor specified by the first document.

24. A method comprising:

a) providing at least one first document and at least one second document to an automated banking machine;

b) determining at least one first type associated with a first input device on the machine, wherein the first input device is associated with at least one first display device on the machine;

c) presenting at least one first user interface through the first display device, responsive to the determined at least one first type, the at least one first document, and the at least one second document, wherein the at least one second document includes at least one language translation of indicia included in the first document.

25. The method according to claim 24, further comprising:

h) substituting for a first command instruction in the at least one first document, a second corresponding command instruction in the at least one second document, wherein the first command instruction includes a first label in a first human language and wherein the second command instruction includes a second label in a dialect of the first human language.

26. Computer readable media bearing instructions which are operative to cause at least one computer in an automated banking machine to cause the machine to carry out a method comprising:

a) receiving at least one first document through operation of the at least one computer in the automated banking machine;

b) *determining through operation of the at least one computer at least one first type associated with a first input device on the machine, wherein the first input device is associated with at least one first display device on the machine;*

c) *presenting at least one first user interface through the first display device, responsive to the determined at least one first type and the at least one first document.*

27. The method according to claim 19, wherein the *first input device and the second input device correspond to different types of input devices,* and further comprising:

f) including in the first user interface at least one *first user interface element that is adapted responsive to step (b) for selection by the first input device.*

g) including in the second user interface at least one *second user interface element that is adapted responsive to step (d) for selection by the second input device.*

28. The method according to claim 27, wherein the document includes a markup language document, wherein the markup language document includes at least one instruction which

specifies the inclusion of a user interface element in a user interface generated responsive to the markup language document, wherein steps (f) and (g) are carried out responsive to the at least one instruction in the markup language document.

29. The apparatus according to claim 1, wherein the automated banking machine includes a first user station and a second user station, wherein the first display device and the first input device are accessible by a user positioned adjacent the first user station, wherein the second display device and the second input device are accessible by a user positioned adjacent the second user station, *wherein both the first user interface and the second user interface are adapted to enable an authorized user to perform servicing operations with the machine while positioned adjacent either the first user station or the second user station of the machine.*

30. The apparatus according to claim 1, wherein the at least one software application is operative responsive to the determined first type, to include in the first user interface, at least one first user interface element which is adapted for selection using the first input device, wherein the at least one software application is operative responsive to the determined second type to include in the second user interface, at least one second user interface element which is adapted for selection using the second input device, wherein the computer is operative to perform a common servicing operation responsive to selection of either the at least one first or the at least one second user interface elements.

31. The apparatus according to claim 30, wherein the first input device includes a plurality of keys, wherein the second input device includes a pointer device.

32. The apparatus according to claim 30, further comprising a markup language document in operative connection with the at least one computer, wherein the at least one software application is further operative to cause the computer to output the first and second user interface elements responsive to the markup language document.

33. The apparatus according to claim 32 wherein the at least one software application includes a plurality of event processors, wherein the markup language document includes a first command instruction which specifies a first one of the event processors, wherein the software application is operative to generate the first and second user interface elements responsive to the command instruction, wherein the at least one software application is operative to invoke the first one of the event processors responsive to the command instruction and responsive to either the first user interface element being selected with the first input device or the second user interface element being selected with the second input device, wherein the event processor is operative to cause the computer to perform the servicing operation.

34. The apparatus according to claim 30, wherein the first user interface element is visually different from the second user interface element.

35. The apparatus according to claim 30, wherein at least one of the transaction function devices includes a cash dispenser, wherein the servicing operation includes servicing the cash dispenser.

36. The apparatus according to claim 30, wherein the at least one computer is operative to receive at least one first input through the first input device, wherein the at least one computer is operative to receive at least one second input through the second input device,

wherein the at least one software application is operative to cause the first user interface to be output through the first display device responsive to the at least one first input and

wherein the at least one software application is operative to cause the second user interface to be output through the second display device responsive to the at least one second input.

37. An automated banking machine apparatus comprising:

a computer;

a cash dispenser in operative connection with the computer;

at least two user stations in operative connection with the computer, wherein a first user station includes at least one first display device and at least one first input device and a second user station includes at least one second display device and at least one second input device;

at least one electronic document in operative connection with the computer, wherein the at least one electronic document includes at least one command instruction; and

a software application operative in the computer, wherein the *software application is operative to cause the computer to determine a first input device type and a second input device type associated respectively with the at least one first input device and the at least one second input device, and to cause a first user interface and a second user interface to be output respectively through the at least one first display and the at least one second display, and to include in the first user interface responsive to the at least one command instruction and the first input device type, at least one first user interface element adapted to be selected through the at least one first input device, and to include in the second user interface responsive to the at least one command instruction and the second input device type, at least one second user interface element adapted to be selected through the at least one second input device.*

38. The apparatus according to claim 37, wherein the at least one first input device comprises a key pad, wherein the at least one second input device comprises a pointing device, wherein the

at least one first user interface element is adapted for selection using the keypad, wherein the at least one second user interface element is adapted for selection using the pointing device.

39. The apparatus according to claim 38, wherein the software application is operative to cause the computer responsive to the selection of either the at least one first user interface element or the at least one second user face element, to cause the machine to perform a servicing function.

40. The apparatus according to claim 37, wherein the at least one electronic document includes a markup language document.